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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------------|
| 10/501,250 | 12/06/2004 | Robert Patrick Hof | 100383 - 1P US | 7528 |
| 9629 7590 09/19/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 | | | EXAMINER SOLOLA, TAOFIQ A | |
| | | | ART UNIT 1625 | PAPER NUMBER |
| | | | MAIL DATE 09/19/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,250

Applicant(s)

HOF, ROBERT PATRICK

Examiner

Taofiq A. Solola

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-8 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kizaki et al., EP 1 024 139 A1 in view of Naik et al., Am. Inst. Chem. Eng. J. (1984), Vol 44(3), pages 612-646.

Applicant claims a process of making compounds of formula I comprising reacting compounds of formulae 2 and 4 in the presence of compound of formula 3, a phosphonium phase transfer catalyst.

Determination of the scope and content of the prior art (MPEP §2141.01)

Kizaki et al., teach a similar process using ammonium phase transfer catalyst.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the instant invention and that of the Kizaki is that Applicant use phosphonium catalyst instead ammonium by Kizaki et al.

Finding of prima facie obviousness—rational and motivation (MPEP §2142.2413)

However, Naik et al., teach that both catalysts are well known in the art and are commonly use as phase transfer catalyst. Therefore, the instant invention is prima facie obvious from the teachings of Kizaki et al., and Naik et al. One of ordinary skill in the art would have known to substitute phosphonium catalyst for ammonium catalyst at the time the invention was made. The motivation is from the teaching of Naik et al.

Response to Argument

Applicant's arguments filed 8/20/07 have been fully considered but they are not persuasive. Applicant contends that Naik et al., fails to teach that ammonium and phosphonium may be used interchangeably. The recent decision in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct 1727, ----, 82 USPQ2d 1385, 1394, 1396 (2007), foreclosed this argument. Applicant further argues that a teaching that both ammonium and phosphonium catalyst are both phase-transfer catalysts cannot be used to conclude they are interchangeable in all systems. This is not persuasive because their recognition as phase transfer catalysts creates an obvious to try situation, and applicant's invention confirms they are in fact interchangeable.

Applicant refers to Halpern's article: Phase Transfer Catalysis Communications (1997) 3:1-12, and contends there is no teaching or suggestion that any catalyst other than ammonium containing catalyst is useful for esterification reaction. This is not persuasive for the reason set forth in *KSR*, Id. Also, the article is not relied upon for the instant rejection.

As per MPEP 2144.06, the issue is not whether two equivalents are recognized as interchangeable, if equivalency is recognized in the prior art, it is obvious to substitute one for the other. The recognition of the catalysts as equivalents by Naik et al., creates an obvious to try situation for applicant.

When there is motivation

to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a

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combination was obvious to try might show that it was obvious under [35 USC] 103.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct 1727,-----, 82 USPQ2d 1385, 1397 (2007). A person of ordinary skill would have good reasons to interchange the catalysts, since there are limited options.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD. JD., whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

A handwritten signature in black ink, appearing to read 'Solola', with a stylized flourish above it.

TAOFIQ SOLOLA
PRIMARY EXAMINER

Group 1625

September 15, 2007